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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,832	11/26/2003	Jeffrey Dryer	12002-1003	9292
36798	7590	05/03/2006	EXAMINER	
RONALD W. BURNS DAVIS MUNCK, P.C. P.O. DRAWER 800889 DALLAS, TX 75380			O'CONNOR, CARY E	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/723,832	DRYER	
	Examiner Cary E. O'Connor	Art Unit 3732	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 February 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 21-40 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 40 is/are allowed.

6) Claim(s) 21-39 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 22604.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-23, 25-30, 35-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller (6,095,815). Mueller shows a dental instrument 1 comprising an actuating assembly, a first grasping member 8 and second grasping member 9 permanently coupled to the actuating assembly at a transition area 7. The grasping assembly is adapted to conform to a desired contour (see Figures 4-6). The instrument facilitates manipulation or placement of a dental matrix to various locations (i.e. mesial interproximal, etc.) as it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but **only requires the ability to so perform**. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. The term "facilitates" is considered to be equivalent to "adapted to". As to claims 25, 28 and 29, note the embodiment of Fig. 6 which shows desired contour comprising a longitudinal curvature. As to claims 26 and 27, note the embodiment of Figure 4, which shows the desired contour comprising a lateral or longitudinal

angulation. As to claim 37, the actuating assembly is bifurcated. As to claim 36, the grasping assembly is formed integrally with the actuating assembly.

Claims 21-25, 29, 30, 34, 36, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Meinershagen (4,836,781). Meinershagen shows a dental instrument comprising an actuating assembly 11, a first grasping member 16 and second grasping member 17 coupled to the actuating assembly at a transition area 18. The grasping assembly is adapted to conform to a desired contour (19, 20). The instrument facilitates manipulation of a dental matrix to various locations (i.e. mesial interproximal, etc.) as it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but **only requires the ability to so perform**. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. The term "facilitates" is considered to be equivalent to "adapted to". As to claims 24, 25, and 29, surfaces 19 and 20 have a contour comprising a longitudinal curvature and a lateral curvature. As to claim 34, the grasping assembly is removably coupled to the actuating assembly (column 2, lines 52-55). As to claim 36, the grasping assembly is formed integrally with the actuating assembly.

Claims 21-25, 28-32 are rejected under 35 U.S.C. 102(b) as being anticipated by *Von Weissenfluh* (5,195,889). *Von Wiessenfluh* shows a dental instrument 2 comprising an actuating assembly, a first grasping member 2' having a first grasping surface 2'' and second grasping member 2" having a second grasping surface 2^{IV} coupled to the actuating assembly at a transition area. The grasping assembly is

adapted to conform to a desired contour (see Figure 2). The instrument facilitates manipulation of a dental matrix 1, to various locations (i.e. mesial interproximal, etc.) as it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. The term "facilitates" is considered to be equivalent to "adapted to". As to claims 24, 25, 28, 29, the grasping surfaces are angled, or curved, to approximate the contour of the matrix, as can be seen in Figs. 3 and 4. One member 2" is concavely curved on the grasping surface and convexly curved on the exterior surface while the other member 2' is concavely curved on the exterior surface and convexly curved on the grasping surface. Because of this, the members are considered to be convexly and concavely curved. As to claims 31 and 32, note that both members 2', 2" has an apical seat near the top of its grasping surface to receive a projection of the matrix (see Fig. 4). As to claim 37, the actuating assembly is bifurcated. As to claim 36, the grasping assembly is formed integrally with the actuating assembly.

Claims 21-25, 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Palermo et al (2002/0106609). Palermo shows a dental instrument comprising an actuating assembly 14, 15, a first grasping member 32 having a first grasping surface and second grasping member 34 having a second grasping surface coupled to the actuating assembly at a transition area. The grasping assembly is adapted to conform to a desired contour (see Figure 2). The instrument facilitates manipulation of a dental matrix 1, to various locations (i.e. mesial interproximal, etc.) as it has been held that the

recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. The term "facilitates" is considered to be equivalent to "adapted to". As to claims 24, 25, 28, 29, the grasping members are angled, or curved, to approximate the contour of the dental appliance, as can be seen in Figs. 15 and 16. One member 34 is concavely curved on the grasping surface 38 and convexly curved on the exterior surface while the other member 32 is concavely curved on the exterior surface and convexly curved on the grasping surface 32. Because of this, the members are considered to be convexly and concavely curved. As to claims 35 and 36, the grasping assembly is formed as part of the actuating assembly and thereby is permanently coupled to the actuating assembly. As to claim 37, the actuating assembly is bifurcated. As to claim 33, note the locking assembly 69 located on the actuating assembly.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-23, 28-32, 34-37 are rejected under the judicially created doctrine of double patenting over claims 5, 6, 2, 7, 14-17 of U. S. Patent No. 6,699,039 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the difference between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims.

Claims 21, 30, 24-27 and 37 are rejected under the judicially created doctrine of double patenting over claims 1, 2, 3, 4, 5, 6, 12 of U. S. Patent No. 6,776,616 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the difference between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic

invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims.

Claim 21 is rejected under the judicially created doctrine of double patenting over claims 14 or 15 of U. S. Patent No. 6,776,616 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the difference between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims.

Allowable Subject Matter

Claim 40 is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 571-272-4715. The examiner can normally be reached on M-Th 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cary E. O'Connor
Cary E. O'Connor
Primary Examiner
Art Unit 3732

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